

## **REMARKS/ARGUMENTS**

Claims 1-20 are under examination in the application. The Office Action mailed on August 17, 2007, includes the following rejections:

1. Claims 1-14 and 16 are rejected under 35 U.S.C. § 112.
2. Claims 1, 2, 11-12, 14 and 16 are rejected under 35 U.S.C. § 103 as being unpatentable.
3. Claim 3 is rejected under 35 U.S.C. § 103 as being unpatentable.
4. Claims 4 and 7-9 are rejected under 35 U.S.C. § 103 as being unpatentable.
5. Claims 5-6 are rejected under 35 U.S.C. § 103 as being unpatentable.
6. Claim 10 is rejected under 35 U.S.C. § 103 as being unpatentable.
7. Claim 13 is rejected under 35 U.S.C. § 103 as being unpatentable.
8. Claims 17-19 are rejected under 35 U.S.C. § 103 as being unpatentable.
9. Claim 20 is rejected under 35 U.S.C. § 103 as being unpatentable.

The amendments to the claims is fully supported by the specification, specifically claims 1-20 and paragraph [0030] of the specification, as such does not introduce new matter.

### ***Claims 1-14 and 16 are rejected under 35 U.S.C. § 112***

The Action rejects claims 1-14 and 16 under 35 U.S.C. § 112 first paragraph. Applicants submit the term “stable at temperatures above 260°C” is fully supported in the application as filed and/or the provisional application. In addition, this is within the scope of the skilled artisan given the specification and the compositions disclosed therein. The skilled artisan knows the temperature achieved in the manufacturing process in which the present invention is used is about 260°C (Range of 232-288) as such the present invention must be able to withstand those temperatures.

### ***Claims 1-2, 11-12, 14 and 16 are rejected under 35 U.S.C. § 103***

The Action rejects claims 1-2, 11-12, 14 and 16 under 35 U.S.C. § 102(b) as being unpatentable over Dorey, et al. (GB 2126211) in view of Denney et al. (U.S Patent No. Re. 34,953). Applicants respectfully submit that claims 1-2, 11-12, 14 and 16 are not obvious over the cited art and is, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

The combination of Dorey and Denney fail to establish a prima facie case of obviousness, as they fail to teach or suggest all the claim limitations and the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose.

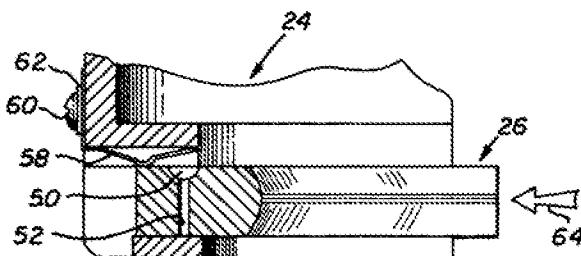
In order to establish a prima facie case of obviousness, three criteria must be met: (1) there must be some suggestion or motivation in the prior art to modify the reference or to combine reference teachings as proposed, (2) there must be a reasonable expectation of success, and (3) the prior art or combined references must teach or suggest all the claim limitations. MPEP § 2143; In re Vacek, 947 F.2d 488 (Fed. Cir. 1991). “The prior art must suggest the desirability of the claimed invention.” MPEP § 2143.01. Both the invention and the prior art references must be considered as a whole. MPEP § 2141.02.

In addition, MPEP Section 2143.01(V) states that “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” Likewise, MPEP Section 2143.01 (VI) states “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.”

The combination of cited references does not teach each and every element in the present invention. Specifically, neither Dorey nor Denney individually teach a **wedge shaped profile** from the front edge to the rear edge adapted to frictionally fit a corresponding wedge shaped semi-circular insert. As such the combination of Dorey and Denney CANNOT teach a **wedge shaped profile**. Although the Action attempts to supply the missing element by the addition of Denney stating:

However, Dorey does not expressly disclose the pocket is tapered with the front edge wider than the rear edge. Denney discloses a takeout holder with pocket that is tapered with the front edge wider than the rear edge as that fits the insert (26, fig. 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the modification as taught by Denney to have a better fit of the insert and the pocket.

This is simply not the case. Denney discloses a takeout jaw with a semi-circular base having a wall having front and rear edges; a semi-circular shelf perpendicular to said wall, forming a pocket with said base; a top parallel to said base extending from said wall towards said front edge of said base; a yoke perpendicular to said top and extending therefrom; and a spring clip attached to the outside of said wall and extending through an opening in said wall formed by cutouts in said wall, said shelf and said base. (See claim 1 of Denney). It is clear from the disclosure of Denny that the pocket is parallel and **NOT** wedge shaped. Specifically, Figures 4 and 7 show the parallel lines of the insert and the parallel lines of the pocket. Figure 7 of Denny is provided below.



There is ABSOLUTELY nothing in Dorey or Denney alone or ANY combination of Dorey and Denney that discloses a wedge shaped pocket or a wedge shaped insert.

In addition, the proposed modification of the combination of Dorey and Denney would render the prior art invention being modified unsatisfactory for its intended purpose. Thus, there is no suggestion or motivation to make the proposed modification. The combination of Dorey and Denney provide a parallel pocket, parallel insert and a metal spring clip (element 58 in figure 7 above) and a depression being in mating relation to retain immovably said insert within said pocket. The combination teaches the use of dissimilar materials having different coefficients of

linear thermal expansion and at the high temperatures of the process, result in different expansion. The present invention does not use a metal clip. Furthermore, the combination of Dorey and Denney would render the prior art invention being modified unsatisfactory for its intended purpose as it is not stable at temperatures above 260°C.

Therefore, the proposed combination of Dorey and Denney does not teach each and every element of the present invention; and even if they did the proposed modifications render the prior art invention being modified unsatisfactory for its intended purpose.

Applicant respectfully submits that the combination fails to establish a *prima facie* case of obviousness, and as such establish a *prima facie* case of obviousness, requests the withdrawal of the rejection under 35 U.S.C. §103.

***Claim 3 is rejected under 35 U.S.C. § 103***

The Action rejects claim 3 under 35 U.S.C. § 103 as being unpatentable over Dorey, et al. (GB 2126211) in view of Denney et al. (U.S Patent No. Re. 34,953) and further in view of Lloyd et al. (US 5,741,343). Applicant respectfully submits that claim 3 is not obvious over the cited art and is, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

As stated above and incorporated herein, the combination of Dorey and Denney fail to establish a *prima facie* case of obviousness, as they fail to teach or suggest all the claim limitations and the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. Lloyd merely teaches stacker bar pads and as such its addition does not cure this deficiency.

The combination of Dorey, Denney and Lloyd does not fulfill the requirements of 35 U.S.C. § 103(a). The combination does not provide each and every element of the present invention and would not work as the present invention. Lloyd teaches against the use of plastics because they cannot withstand the temperatures AND Dorey teaches against the use of ceramic materials because they are brittle and easily chipped. The skilled artisan would not have looked to the combination of Dorey and Lloyd to address the problem of the present invention. Furthermore,

given the teachings of Dorey, Denney and Lloyd the skilled artisan would have no indication that the combination would work. As a result, Applicant respectfully submits that the claim as amended, is not obvious over the cited art and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

***Claims 4 and 7-9 are rejected under 35 U.S.C. § 103***

The Action rejects claims 4 and 7-9 under 35 U.S.C. § 103 as being unpatentable over Dorey, et al. (GB 2126211) in view of Denney et al. (U.S Patent No. Re. 34,953) in view of Lloyd et al. (US 5,741,343) and further in view of Oberlin (U.S Patent 3,473,938). Applicant respectfully submits that claims 4 and 7-9 are not obvious over the cited art and is, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

As stated above and incorporated herein, the combination of Dorey, Denney and Lloyd fail to establish a *prima facie* case of obviousness, as they fail to teach or suggest all the claim limitations and the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. The addition of Oberlin does not cure this deficiency.

Furthermore, there still must be some suggestion or motivation in the prior art to modify the reference or to combine reference teachings as proposed. Applicant submits that there is no such motivation for the combination of Dorey **with** Denney **and** Lloyd **and** Oberlin.

The combination of Dorey, Denney, Lloyd and Oberlin does not fulfill the requirements of 35 U.S.C. § 103(a). The combination does not provide each and every element of the present invention and would not work as the present invention. As a result, Applicant respectfully submits that the claim as amended, is not obvious over the cited art and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

***Claims 5-6 are rejected under 35 U.S.C. § 103***

The Action rejects claims 5-6 under 35 U.S.C. § 103 as being unpatentable over Dorey, et al. (GB 2126211) in view of Denney et al. (U.S Patent No. Re. 34,953) and further in view of

Nishikawa et al. (U.S Patent No. 4,900,807). Applicant respectfully submits that claims 5-6 are not obvious over the cited art and is, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

As stated above and incorporated herein, the combination of Dorey and Denney fail to establish a *prima facie* case of obviousness, as they fail to teach or suggest all the claim limitations and the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. Nishikawa merely discloses polymers obtained by polymerizing a nitrile-terminated Schiff compound alone or together with other monomers and as such its addition does not cure this deficiency.

As a result, Applicant respectfully submits that the claim as amended, is not obvious over the cited art and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

***Claim 10 is rejected under 35 U.S.C. § 103***

The Action rejects claim 10 is rejected under 35 U.S.C. § 103 as being unpatentable over Dorey, et al. (GB 2126211) in view of Denney et al. (U.S Patent No. Re. 34,953) in view of Lloyd et al. (US 5,741,343) and further in view of Recker et al. (U.S Patent No. 6,523,768). Applicant respectfully submits that claim 10 is not obvious over the cited art and is, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

As stated above and incorporated herein, the combination of Dorey, Denney and Lloyd fail to establish a *prima facie* case of obviousness, as they fail to teach or suggest all the claim limitations and the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. The addition of Recker does not cure this deficiency.

Recker discloses a rotor assembly for comminuting [i.e., to reduce to minute particles, pulverize; to triturate; to grind] scrap wood and other like material has a rotor drum including a drive shaft and at least one radially projecting tool supporting member with a tool assembly receiving pocket. The design of Recker is fundamentally different than the present invention and would

not function as the present invention. Recker includes an opening that is larger at the back and smaller at the front. As a result of this design the insert must be a 2-piece design that uses a screw to move the insert into place. Therefore, the design of Recker is totally different from the present invention and would not function in conjunction with the present invention.

The combination of Recker would produce a proposed modification would renders the prior art invention being modified unsatisfactory for its intended purpose. It would be unsatisfactory and inoperable to use a multiple piece insert with a metal screw to retain the insert in the present invention. Furthermore, there still must be some suggestion or motivation in the prior art to modify the reference or to combine reference teachings as proposed. Applicant submits that there is no such motivation for the combination of Dorey **with** Denney **and** Lloyd **and** Recker.

The combination of Dorey, Denney, Lloyd and Recker does not fulfill the requirements of 35 U.S.C. § 103(a). The combination does not provide each and every element of the present invention and would not work as the present invention. As a result, Applicant respectfully submits that the claim as amended, is not obvious over the cited art and, therefore, respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a).

***Claim 13 is rejected under 35 U.S.C. § 103***

The Action rejects claim 13 is rejected under 35 U.S.C. § 103 as being unpatentable over Dorey, et al. (GB 2126211) in view of Mohler et al. (U.S 6,805,832). Applicant respectfully submits that claim 13 is not obvious over the cited art and is, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

In order to establish a prima facie case of obviousness, three criteria must be met: (1) there must be some suggestion or motivation in the prior art to modify the reference or to combine reference teachings as proposed, (2) there must be a reasonable expectation of success, and (3) the prior art or combined references must teach or suggest all the claim limitations. MPEP § 2143; *In re Vacek*, 947 F.2d 488 (Fed. Cir. 1991). “The prior art must suggest the desirability of the claimed invention.” MPEP § 2143.01. Both the invention and the prior art references must be considered as a whole. MPEP § 2141.02.

The combination of cited references does not teach each and every element in the present invention. Specifically, neither Dorey nor Mohler individually teach a **wedge shaped profile** from the front edge to the rear edge adapted to frictionally fit a corresponding wedge shaped semi-circular insert. As such the combination of Dorey and Mohler CANNOT teach a **wedge shaped profile**.

Furthermore. Mohler discloses a thermite torch cutting nozzle that is fabricated from a material selected from the group consisting of mineralphenolic and high temperature plastic. At the very most Mohler discloses the "...mineral/phenolic. High temperature plastics, such as glass-filled polyetheretherketone, may also be used for such nozzles" (see column 4, lines 23-25; emphasis added). However, Mohler provides no guidance to any parameters compositions or specifics other than the use of the term mineral/phenolic and glass-filled polyetheretherketone. The material must be suitable for the desired purpose, which includes limiting the transfer of materials from the holder/insert to the bottle, reducing marring of the bottle.

The combination of Dorey and Mohler does not teach a takeout holder formed of plastic with a plastic that provides a longer life expectancy and is stable at temperatures above 260°C. Applicant respectfully submits that the claim as amended, is not obvious over the cited art and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

### *Claims 17-19 are rejected under 35 U.S.C. § 103*

The Action rejects claims 17-19 are rejected under 35 U.S.C. § 103 as being unpatentable over Denney et al. (U.S Patent No. Re. 34,953) in view of Kume et al. (JP 04160065 A). Applicant respectfully submits that claims 17-19 are not obvious over the cited art and is, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

Specifically, neither Denney (as stated above and incorporated herein) nor Kume individually a **wedge shaped profile** from the front edge to the rear edge **adapted** to frictionally fit a corresponding **wedge shaped semi-circular insert**. As such the combination of Denney and Kume CANNOT teach a wedge shaped profile and the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. Applicant respectfully

submits that the claims as amended, are not obvious over the cited art and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

***Claim 20 is rejected under 35 U.S.C. § 103***

The Action rejects claims 20 is rejected under 35 U.S.C. § 103 as being unpatentable over Denney et al. (U.S Patent No. Re. 34,953) in view of Kume et al. (JP 04160065 A) in view of Filges et al. (U.S Patent 6517597). Applicant respectfully submits that claim 20 is not obvious over the cited art and is, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

As stated above and incorporated herein, Denney and Kume do not **identically disclose every element** of the claimed invention. The combination of Denney and Kume does not teach a takeout holder having a **wedge shaped profile** from the front edge to the rear edge **adapted** to frictionally fit a corresponding **wedge shaped semi-circular insert**. The addition of a glaze by Filges does not cure this deficiency.

Applicant respectfully submits that the claim as amended, is not obvious over the cited art and, therefore, respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

**Conclusion**

In light of the remarks and arguments presented above, Applicant respectfully submits that the claims in the Application are in condition for allowance. Favorable consideration and allowance of the pending claims 1-20 are therefore respectfully requested. If the Examiner has any questions or comments, or if further clarification is required, it is requested that the Examiner contact the undersigned at the telephone number listed below.

Dated: December 17, 2007.

Respectfully submitted,



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